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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,743	09/23/2005	Masahiro Karatsu	890050.530USPC	6067
500 7590 03/27/2008 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 5400 SEATTLE, WA 98104				
EXAMINER MAYES, MELVIN C				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
03/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/550,743

## Applicant(s)

KARATSU ET AL.

## Examiner

Melvin C. Mayes

## Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 9/23/05, 8/14/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

(1)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(2)

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 claims "multi-layered units each formed by laminating a release layer, an electrode layer and a ceramic green sheet on a support sheet in this order" and claims "laminating multi-layered units on the base substrate." It is unclear as claimed whether the support sheets are a part of the multi-layered units laminated on the base substrate. According to the specification, after pressing, the support sheet is peeled, and a new multi-layered unit is further laminated on the multi-layered unit on the base substrate. The claim is not clear.

In Claim 1, line 6 reads "green sheet is contact" which is unclear.

Claim 1 recites the limitation "the support substrate" in line 8. There is insufficient antecedent basis for this limitation in the claim. There is a "base substrate."

Claim 1 claims "itself" in lines 8 and 10 however it is not clear which of the layers this refers to. The claim should read "the agglutinant layer."

Claims 9 and 10 recite the limitation "the binder." There is insufficient antecedent basis for this limitation in the claim. Binder is first claimed in Claim 3.

### ***Double Patenting***

(3)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(4)

Claims 1-3, 5, 7, 11 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10, 13, 16, 20 and 24 of copending Application No. 10/550,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Copending Application No. 10/550,713 claims a method for manufacturing a multi-layered ceramic electronic component comprising:

positioning a multi-layered unit formed on a support sheet wherein the multi-layered unit includes a release layer, an electrode layer and a ceramic green sheet, the electrode layer positioned between the release layer and the ceramic green sheet, so that a surface of the ceramic

green sheet of the multi-layered unit comes into contact with a surface of an agglutinant layer formed on a base substrate;

pressing the multi-layered unit toward the base substrate; and

laminating the multi-layered unit on the base substrate, wherein the base substrate has such surface roughness as to include per  $0.01 \text{ mm}^2$  thereof not more than one protrusion that can penetrate the ceramic green sheet of the multi-layered unit laminated on the base substrate to half or more a thickness of the ceramic green sheet and include per  $100 \text{ mm}^2$  thereof not more than one protrusion that can completely penetrate the ceramic green sheet,

wherein the agglutinant layer is formed on a surface of the base substrate in such a manner that a bonding strength between the agglutinant layer and the base substrate is higher than a bonding strength between the support sheet and the release layer and lower than a bonding strength between the agglutinant layer and the ceramic green sheet, and either:

wherein the agglutinant layer has a thickness of  $0.01 \text{ }\mu\text{m}$  to  $0.3 \text{ }\mu\text{m}$ ,

wherein the agglutinant layer contains a binder belonging to a same binder group as that of a binder contained in the ceramic green sheet,

wherein the agglutinant layer contains a plasticizing agent belonging to a same binder group as that of a plasticizing agent contained in the ceramic green,

wherein the agglutinant layer contains dielectric particles having a same composition as that of dielectric particles contained in the ceramic green sheet,

wherein the base substrate is formed of a plastic material selected from a group consisting of polyethylene, polypropylene, polycarbonate, polyphenylene ether and polyethylene terephthalate, or

wherein the ceramic green sheet has a said thickness equal to or thinner than 3  $\mu\text{m}$ .

Laminating multiple multi-layered units on the base substrate after peeling the support sheet from each multi-layered unit would have been obvious to one of ordinary skill in the art to form a multi-layered ceramic electronic component from multiple multi-layered units.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Allowable Subject Matter*

(5)

The following claim 1 drafted by the examiner and considered to overcome the 35 U.S.C. 112, second paragraph rejection and distinguish patentably over the art of record in this application, is presented to applicant for consideration and would be allowable with a terminal disclaimer filed to overcome the nonstatutory double patenting rejection:

1. A method for manufacturing a multi-layered ceramic electronic component by laminating a plurality of multi-layered units, each multi-layer unit formed on a support sheet by laminating a release layer, an electrode layer and a ceramic green sheet on a support sheet in this order, the method comprising steps of:

positioning the multi-layered unit on a base substrate so that the surface of the ceramic green sheet is contact with an agglutinant layer formed on the surface of the base substrate in such a manner that the bonding strength between the agglutinant layer and the support substrate is higher than the bonding strength between the support sheet and the release layer and

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lower than the bonding strength between the agglutinant layer and the ceramic green sheet;

pressing it;

peeling the support sheet from the release layer; and

laminating additional multi-layered units on the base substrate.

### ***Conclusion***

(6)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin C. Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melvin C. Mayes  
Primary Examiner  
Art Unit 1791

MCM  
March 24, 2008

/Melvin C. Mayes/  
Primary Examiner, Art Unit 1791